REMARKS

After the foregoing Amendment, claims 10-14 are currently pending in this application. Claims 1-9 have been canceled without prejudice, as being directed to a non-elected invention.

Allowable Subject Matter

The Examiner is thanked for indicating that claims 11-14 contain allowable subject matter.

Claim Rejections - 35 USC §112

Claims 10-14 stand rejected under 35 U.S.C. §112, first paragraph, for failing to comply with the enablement requirement. In particular, the Examiner argues that it is "impossible or illogical to have both conditions [i.e., the two "if" clauses] to be met or executed at the same time" and bases this argument on the term "and" being recited between the two "if" statements.

Applicants respectfully direct the Examiner's attention to the language of claim 10 - there is no "and" between the two "if" clauses. The Examiner has read this term into the claims when it does not appear; therefore, the Examiner does not have a basis for this argument. Furthermore, one of ordinary skill in the art would be able to properly interpret the first "if" clause, which recites that the method will

end if the first "if" clause is performed. Based on the plain meaning of the language of the first "if" clause, it is not logically possible for the second "if" clause to also be performed, because the method would end when the first "if" clause was performed - before the second "if" clause would be reached. Accordingly, one of skill in the art would be able to make or use the invention as recited in claim 10.

Based on the arguments presented above, withdrawal of the 35 U.S.C. §112 rejection of claims 10-14 is respectfully requested.

Claim Rejections - 35 USC §102(e)

Claim 10 stands rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,615,386 to Yano et al. (hereinafter "Yano").

Yano relates to an error correcting apparatus for receiving a signal subject to repetition processing (column 1, lines 6-13). The apparatus includes a repetition generator, a repetition rate calculator, a soft decision data but-off position decision unit, and a soft decision data cutting means (column 6, lines 1-5). A TFCI detector 57 detects TFCI bits and inputs them into a DSP 62. The DSP analyzes the TFCI bits for one frame and obtains a number of bits per frame before the repetition and a number of bits per frame increased due to the repetition by referring to the analyzed TFCI and looking up the TFCI value in a conversion table (column 12, lines 51-55).

The Examiner argues that Yano, at column 11, lines 11-22 and 57-59 and column 12, lines 51-63 teaches the steps of evaluating the TFCI value to determine if it is a valid index of a transport format combination set (TFCS); if the TFCI value is a valid index of the TFCS, then using the TFCI value obtained in said decoding step and ending the method; if the TFCI value is not a valid index of the TFCS, then selecting a valid TFCI value and using the selected TFCI value. Applicants respectfully disagree.

Yano does not disclose anything relating to a TFCS or an index of a TFCS. As noted above, Yano uses the TFCI information to determine a number of bits per frame before the repetition and a number of bits per frame increased due to the repetition.

Because Yano does not teach all of the elements of claim 10 (i.e., evaluating the TFCI value to determine if it is a valid index of a TFCS and selecting a TFCI value to use), the present invention is distinguishable over Yano. Claims 11-14 are dependent upon claim 10, which the Applicants believe are allowable over the cited prior art of record for the same reasons provided above.

Based on the arguments presented above, withdrawal of the 35 U.S.C. §102(e) rejection of claims 10-14 is respectfully requested.
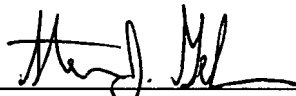
Conclusion

If the Examiner believes that any additional minor formal matters need to be addressed in order to place this application in condition for allowance, or that a telephone interview will help to materially advance the prosecution of this application, the Examiner is invited to contact the undersigned by telephone at the Examiner's convenience.

In view of the foregoing amendment and remarks, Applicants respectfully submit that the present application, including claims 10-14, is in condition for allowance and a notice to that effect is respectfully requested.

Respectfully submitted,

DiFazio et al.

By_____
Steven J. Gelman
Registration No. 41,034

Volpe and Koenig, P.C.
United Plaza, Suite 1600
30 South 17th Street
Philadelphia, PA 19103
Telephone: (215) 568-6400
Facsimile: (215) 568-6499
SJG/mnr